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09/757,761	01/09/2001	Peter F. Theis	ITT-006.C2	8046

7590 04/09/2004  
Samuel Kassatly  
6819 Trinidad Drive  
San Jose, CA 95120

EXAMINER

PHAM, TUAN

ART UNIT	PAPER NUMBER
2643	2

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/757,761

Applicant(s)

THEIS, PETER F.

Examiner

TUAN A PHAM

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the switching code" in line 4. There is insufficient antecedent basis for this limitation in the claim.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-61 of U.S. Patent No. 5,917,904;

claims 1-36 of U.S. Patent No. 6,201,864. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 in the constant application have the same scope of claimed invention with obvious words and variations. Each of the above patents includes a telephone instrument, computer, auto-dialer, and a method for the automatic dialing of local and long distance calls in the United States, as well as automatic dialing of international calls. The system comprising the element of the telephone, computer, which is included a memory, a database, and a control unit associated with voice dialing and voice recognition techniques.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomiyori (U.S. patent No. 5,305,372).

**Regarding claim 1**, Tomiyori teaches a method of out-dialing an address having a plurality of digits, comprising:

initiating a call by dialing a sequence of digits representing the address to be out-dialed (see col.1, ln.55-65, col.3, ln.60-65);

recognizing at least a part of the dialed digits, and further recognizing the sequence of the recognized dialed digits (see col.1, ln.55-65, col.3, ln.58-67);

before the address is out-dialed, searching a data base that includes at least portions of a plurality of digits for the recognized dialed digits, and for the recognized sequence of the recognized dialed digits (see col.1, ln.45-67);

before the address is out-dialed, matching the digits and the sequence to digits in a data base of addresses requiring special handling (i.e., country code)(see col.4, ln.13-39); and

if there is no match in the data base, searching a data base that includes at least portions of a plurality of previously out-dialed addresses for the recognized dialed digits (see col.4, ln.13-39).

**Regarding claim 2**, Tomiyori teaches a method of out-dialing an address having a plurality of digits, comprising:

initiating a call by dialing a sequence of digits representing an address to be out-dialed (see col.1, ln.55-65, col.3, ln.60-65);

recognizing at least a part of the dialed digits, and further recognizing the sequence of the recognized dialed digits (see col.1, ln.55-65, col.3, ln.58-67);

before the address is out-dialed, searching a data base that includes at least portions of a plurality of previously out-dialed addresses, for the recognized dialed digits (see col.1, ln.45-67);

before the address is out-dialed, automatically searching a data base of addresses that require special handling (country code) for the recognized dialed digits, and for the recognized sequence of the recognized dialed digits (see col.4, ln.13-39);  
and

before the address is out-dialed, automatically matching the digits and the sequence to digits in a data base of addresses requiring special handling (see col.4, ln.13-39).

**Regarding claim 4**, Tomiyori teaches an apparatus for out-dialing an address, comprising;

a data base including at least portions of a plurality of previously out-dialed addresses (see col.1, ln.45-67);

the data base including information about a switching code (i.e., area code, toll area code) for each of the previously out-dialed addresses (see figure 1, memory 11, col.1, ln.44-55);

a data base of addresses for a plurality of switching codes, including information about the switching code for each address; a connection between the data base of addresses for a plurality of switching codes, and the data base of previously out-dialed addresses (see figure 1, memory 11, col.1, ln.44-55);

at least one-number in the data base of addresses for a plurality of switching codes matching at least one address in the data base of previously out-dialed addresses (see col.4, ln.13-39); and

the connection causing the identified previously out-dialed address to be changed in the data base of previously out-dialed addresses (see col.1, ln.60-67, col.2, ln.1-9).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomiyori (U.S. patent No. 5,305,372) in view of Kaneuchi et al. (U.S. Patent No. 4,945,557, hereinafter, "Kaneuchi").

**Regarding claim 3**, Tomiyori teaches a method of out-dialing a telephone number, comprising:

initiating a call by dialing a sequence of digits representing the phone number to be out-dialed (see col.1, ln.55-65, col.3, ln.60-65);

recognizing at least a part of the dialed digits, and further recognizing the sequence of the recognized dialed digits (see col.1, ln.55-65, col.3, ln.58-67);

causing the associated phone number to be out-dialed (see col.4, ln.5-39).

It should be noticed that Tomiyori fails to clearly teach searching a data base (i.e. memory) that includes one or more key words established by a party independent of the caller and linked with the telephone number to be out-dialed; before the number is out-dialed, automatically matching the dialed digits and the key words in the data base of key words; matching the dialed sequence of digits to a key word in the data base. However, Kaneuchi teaches such features (see col.4, ln.38-67, col.5, ln.1-24, col.7, ln.1-60) for a purpose of dialing a part of the telephone number.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of searching a data base (i.e. memory) that includes one or more key words established by a party independent of the caller and linked with the telephone number to be out-dialed; before the number is out-dialed, automatically matching the dialed digits and the key words in the data base of key words; matching the dialed sequence of digits to a key word in the data base, as taught by Kaneuchi, into view of Tomiyori in order to save time and without remember the long telephone number.

**Regarding claim 5**, Tomiyori teaches a method of out-dialing an address having a plurality of digits, comprising:

initiating a call by dialing a sequence of digits representing the address to be out-dialed (see col.1, ln.55-65, col.3, ln.60-65);

recognizing at least a part of the dialed digits, and further recognizing the sequence of the recognized dialed digits (see col.1, ln.55-65, col.3, ln.58-67);

before the address is out-dialed, searching a data base that includes at least portions of a plurality of digits for the recognized dialed digits, and for the recognized sequence of the recognized dialed digits (see col.1, ln.45-67);

before the address is out-dialed, matching the digits and the sequence to digits in a data base of addresses requiring special handling (i.e., country code)(see col.4, ln.13-39); and



if there is no match in the data base, searching a data base that includes at least portions of a plurality of previously out-dialed addresses for the recognized dialed digits (see col.4, ln.13-39).

It should be noticed that Tomiyori fails to clearly teach the voice recognition in the telephone system. However, Kaneuchi teaches such features (see col.4, ln.38-67, col.5, ln.1-24, col.7, ln.1-60) for a purpose of making a call without dialing the telephone number.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of voice recognition in the telephone system, as taught by Kaneuchi, into view of Tomiyori in order to allow for hand-free operation.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In order to expedite the prosecution of this application, the applicants are also requested to consider the following references. Although Nixon et al. (U.S. Patent No. 5,475,743), Marutiak (U.S. Patent No. 5,568,546), Breeden (U.S. Patent No. 5,459,774), and Waldman (U.S. Patent No. 5,157,719) are not applied into this Office Action, they are also called to Applicants attention. They may be used in future Office Action(s). These references are also concerned for supporting the system and method for automatic dialing the area code of cellular or other type of telephone system and dynamic abbreviated dialing assignment.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (703) 305-4987. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz can be reached on (703) 305-4708 and

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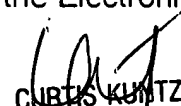
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CURTIS KUNTZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600